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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,582	12/15/2003	Ann Marie Pendergast	1579-872	1952
23117	7590	06/28/2007	EXAMINER	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			GITOMER, RALPH J	
		ART UNIT	PAPER NUMBER	
		1657		
		MAIL DATE	DELIVERY MODE	
		06/28/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/734,582	PENDERGAST ET AL.
	Examiner	Art Unit
	Ralph Gitomer	1657

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 June 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 7-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 7-22 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

The RCE Request, IDS and amendment received 6/13/07 have been entered and claims 7-22 are currently pending in this application.

Although not claimed, a search reveals preventing or treating infection by *Shigella flexneri* with STI571 is novel.

Claims 7-22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for preventing or treating *S. flexneri* with STI571 in cell culture, does not reasonably provide enablement for treating any pathogen with any Abl tyrosine kinase inhibitor in humans. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

In claim the terms "a pathogen" and "an inhibitor of Abl tyrosine kinase" lack enablement as it would require one of ordinary skill in this art undue experimentation to determine which such pathogen or inhibitor would work in the instant invention.

The entire scope of the claims has not been enabled because:

1. Quantity of experimentation necessary would be undue because of the large proportion of inoperative pathogens or inhibitors claimed.
2. Amount of direction or guidance presented is insufficient to predict which pathogens or inhibitors encompassed by the claims would work. First, one would need to know what compounds or collection of compounds are inhibitors of Abl tyrosine kinase and then one would need to know which of those compounds would be effective to treat a given pathogen.

3. Presence of working examples are only for a single specific pathogen and inhibitor in a cell culture and extension to other pathogens or inhibitors has not been specifically taught or suggested.
4. The nature of the invention is complex and unpredictable. To know what drug is useful to treat what pathogen is not simple when one knows what the pathogen is and has a given selection of drugs. And to know what compound would selectively inhibit Abl tyrosine kinase and thereby treat any pathogen infection, ranging from fleas to systemic fungal infections, is unpredictable.
5. State of the prior art indicates that most related pathogens and inhibitors are not effective for the claimed functions.
6. Level of predictability of the art is very unpredictable.
7. Breadth of the claims encompasses an innumerable number of pathogens and inhibitors.
8. The level of one of ordinary skill in this art is variable.

In re Wands, 858 F.2d 731, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)

Applicant's arguments filed 6/13/07 have been fully considered but they are not persuasive.

Applicants argue that no evidence has been presented that the invention cannot be practiced as claimed. The specification states that the invention is applicable to other pathogens using other Abl kinase inhibitors. References are provided written after the priority date of this application that show Abl kinases inhibit a virus.

It is the examiner's position that no credible evidence is presented to show that any such inhibitor will be effective to prevent or treat any infection, viral, bacterial, or other pathogen in humans. The references presented were available after the priority date of this application and so do not teach what was in the possession of the inventors at the time the invention was made. As presented, the claims read on treating slow virus to prion infections which are not likely to work.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ralph Gitomer whose telephone number is (571) 272-0916. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on (571) 272-0925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

R. Gitomer

Ralph Gitomer
Primary Examiner
Art Unit 1657